

Applicants: Peter S. Linsley et al.
U.S. Serial No.: 09/454,651
Filed: December 6, 1999
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Support for the amended and new claims may be found as follows:

Support for claim 40 is found in the originally filed specification at page 47, lines 9-11 and at page 35, lines 1-4.

Support for claim 44 is found in the originally filed specification at page 47, lines 9-11.

Support for new claim 45 is found in the originally filed application at page 47, lines 9-11, page 35, lines 1-4 and page 36, lines 32-34.

Concurrent with this amendment, Applicants submit a Petition for Correction of Inventorship (Exhibit 1). The proper and correct inventors in view of currently pending claims are: (1) Peter S. Linsley, (2) Jeffery A. Ledbetter, (3) Nitin K. Damle, and (4) William Brady. Please change the inventorship accordingly.

The correct inventors were properly named in the subject application for the originally filed claims. The subject application was originally filed with claims 1-37, and (1) Peter S. Linsley, (2) Jeffery A. Ledbetter, (3) Nitin K. Damle, (4) William Brady, and (5) Philip M. Wallace as inventors. In the course of prosecution, Applicants added new claims 38-45, and canceled claims 1-37, 39 and 41-42. Claims 38, 40, 43, 44 and 45 are currently pending. Philip M. Wallace is not inventor of currently pending claims 38, 40, 43, 44 and 45. Therefore, Applicants respectfully request that Philip Wallace be removed as inventor of the claims in the subject application.

Applicants submit herein a Petition for Correction of Inventorship under 37 C.F.R. §1.48(b) signed by a registered attorney acting in a representative capacity in compliance with 37 C.F.R. §1.33(b) (Exhibit 1). In accordance with 37 C.F.R. §1.48(b)(2), Applicants authorize the Patent Office to charge Deposit Account No. 50-0306 the amount of \$130.00 under 37 C.F.R. §1.17(i).

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In view of the remarks provided herein, Applicants respectfully request reconsideration of the application and allowance of the claims.

Applicants are pleased that the amendments and declaration filed March 13, 2002, have been entered.

FORMAL DRAWINGS

Item 4

At page 2, the Patent Office stated that formal drawings and photographs have been submitted which fail to comply with 37 CFR §1.84.

In response, the Applicants hereby submit formal drawings for Figures 17, 18, 20A, 20B, and 21 (Exhibit 2). The formal drawings 17, 18, 20A, 20B, and 21 incorporate the Corrections of the Drawings, as required by the Office Action mailed September 13, 2001 and the PTO-948 Form. The formal Figures 17, 18, 20A, 20B, and 21 do not introduce new matter; accordingly, their entry is respectfully requested.

TYPOGRAPHICAL ERRORS AND TRADEMARKS

At page 3, the Patent Office required that the subject application be reviewed and all spelling, TRADEMARKS, and like errors corrected. Applicants had previously reviewed the application for spellings, TRADEMARKS, and other typographical errors, and in the amendment filed March 13, 2002, Applicants provided an amended specification that corrected any spelling errors, TRADEMARKS, and other typographical errors.

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Item 5

Applicants appreciate that the Examiner has withdrawn rejections under 35 U.S.C §112, first and second paragraph.

REJECTION UNDER 35 U.S.C. §102(e)

Item 6

The Office rejected claims 38, 40, 43 and 44 under 35 U.S.C. §102(e) as allegedly anticipated by Linsley et al. (U.S. Patent No. 5,580,756) for the reasons of record set forth in the previous Office Action (Paper No. 13).

The inventors of the claimed invention are Drs. Peter Linsley, Jeffrey Ledbetter, Nitin Damle, and William Brady (Exhibit 1). The inventors of the claimed invention and the claims of the '756 patent are the same; hence, the invention was not described in a patent by another as required under 35 U.S.C. §102(e). Accordingly, the 35 U.S.C. §102(e) rejection is moot.

CONCLUSION

Applicants believe that all grounds for rejection of the claims have been successfully overcome and that the claims are now in condition for allowance. Withdrawal of the Examiner's remaining rejections is requested and prompt allowance of the claims is solicited. If any issues remain in connection with the claims, the Examiner is encouraged to contact the undersigned by telephone to discuss the same.

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No fee, other than the \$130.00 fee for Petition to Correct Inventorship, is deemed necessary in connection with the filing of this response. The Patent Office is authorized to charge the \$130.00 petition fee and any additional fee, if necessary, to Deposit Account No. 50-0306.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE IN THE SPECIFICATION

In the Claims:

Please amend claims 40 and 44 as follows:

--40. (twice amended) The method of claim 38, wherein the soluble B7 [protein] is the extracellular domain of B7 joined to at least a portion of an immunoglobulin molecule. --

--44. (amended) The method of claim 40, wherein the soluble B7 [protein] is a B7Ig fusion protein. --

Please add new claim 45 as follows:

--45. (new) The method of claim 38, wherein the extracellular domain of B7 begins at position 1 and ends at position 215 of SEQ ID NO.: 23 joined to at least a portion of an immunoglobulin molecule.